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REMARKS

Reconsideration of this application in view of the above amendments and following remarks is respectfully requested. Claims 24-43 are pending. Claims 1-23 and 44-65 have been canceled. Claims 26 and 39 have been amended.

Restriction Requirement

Pursuant to 35 U.S.C. §121, the Examiner has entered a three-way restriction requirement as follows:

Group I: Claims 1-21, 24-43, 55 and 65 directed to a weatherproof sheet;

Group II: Claims 22 and 23 directed to a book or notepad comprising a plurality of weatherproof sheets; and

Group III: Claims 44-54 and 56-64 directed to a method of making a weatherproof sheet.

Applicants hereby elect the product of Group I – that is, the weatherproof sheet recited in claims 1-21 and 24-43. Accordingly, Applicants have canceled the Group II and III claims. Of course, Applicants reserve the right to continue prosecution of the canceled subject matter in one or more divisional applications.

In addition, Applicants have also canceled product-by-process claims 55 and 65. While such claims were included within the Group I product claims, Applicants believe that it would be more appropriate to pursue this subject matter in conjunction with the corresponding process claims of Group III.

Lastly, and in order to expedite consideration of one embodiment of this invention, Applicants have canceled product claims 1-21. Cancellation of these claims is not meant as an acquiescence to any ground of rejection applied thereto. Rather, Applicants merely wish to expedite allowance of the subject matter of claims 24-43, which claims are directed to a weatherproof sheet suitable for use in a photocopier or laser printer. Applicants reserve the right to continue prosecution of the subject matter of claims 1-21 in one or more related continuation applications.

Accordingly, in view of the above election and amendments, claims 24-43 are now pending.

35 U.S.C. §112, Second Paragraph, Rejection

Claims 26 and 39 stand rejected under the second paragraph of §112 as indefinite for inclusion of the trademarks Lucidene[®] and Rite in the Rain[®]. Applicants have amended claims 26 and 39 in the manner requested by the Examiner; namely, by replacing the trademarked terms with a generic description. More specifically, Applicants have amended claim 26 to recite “an acrylic or styreneacrylic emulsion” in place of Lucidene[®] 605, and have amended claim 39 to recite “a compounded acrylic” in place of Rite in the Rain[®] Formula #22560B.

In addition, claim 24 stands rejected as indefinite with regard to the word “tooth”. As used in the paper industry, “tooth” refers to a slightly rough paper which readily permits acceptance of ink. For the Examiner’s reference, attached is page 20-107 from “Walden’s Paper Handbook,” 3rd Ed., 1995, which supports this definition.

Accordingly, Applicants respectfully submit that the pending claims satisfy the second paragraph requirement of §112 and request that this ground of rejection be withdrawn.

35 U.S.C. §102(e) Rejection

As noted above, Claims 1-21 have been canceled in order to expedite consideration and allowance of the subject matter of claims 24-43. As this ground of rejection has not been applied to the now pending claims (i.e., claims 24-43), Applicants request that it be withdrawn.

35 U.S.C. §102(b) Rejection

Claims 24, 25, 28-37 and 40-43 stand rejected under §102(b) as anticipated by U.S. Patent No. 5,919,552 to Malhotra (hereinafter “Malhotra”) for the reasons set forth in the Office Action at pages 6-8. Applicants respectfully disagree.

Pending claims 24-43 are directed to a weatherproof sheet suitable for use in a photocopier or laser printer. As discussed in the specification at, for example, page 13, lines 10-21, titanium dioxide and calcium carbonate have been found to foul such equipment. For this reason, claim 24 recites that the coating layer "comprises substantially no calcium carbonate filler and substantially no titanium dioxide pigment". This aspect of the claimed invention is not taught by Malhotra.

Rather, Malhotra is directed to a coated substrate, particularly in the context of "generating gloss on an image wherein hydrophobic, abrasion resistant, polymeric transparent coatings are transferred on to the image by heat and pressure from a coated release substrate" (col. 1, lines 17-20). Apart from the fact that the waterproof sheet of this invention is distinct from the coated substrate disclosed in the Malhotra patent, Malhotra requires the presence of a filler which, as noted by the Examiner, includes calcium carbonate and titanium dioxide.

Accordingly, the "negative proviso" of claim 24 (*i.e.*, that the coating layer comprises substantially no calcium carbonate or titanium dioxide) is clearly not satisfied by Malhotra. Thus, Applicants submit that the subject matter of claims 24-43 is not anticipated, and request that this ground of rejection be withdrawn.

35 U.S.C. §103(a) Rejections

Claim 27 stands rejected under §103(a) as obvious over Malhotra in view of U.S. Patent No. 6,028,028 to Nitta (hereinafter "Nitta") for the reasons set forth in the Office Action at pages 8-9. In addition, claim 24 stands rejected as obvious over Nitta in view of Malhotra for the reasons set forth in the Office Action at pages 9-10. For purpose of brevity, Applicants will address both grounds of rejection simultaneously below.

As noted above, Malhotra does not teach the waterproof sheet as recited in the pending claims, specifically the limitation that the waterproof sheet comprises substantially no calcium carbonate or titanium dioxide. Furthermore, Malhotra does not recognize the fouling problems associated with photocopying or laser printing of such sheets, and thus does not suggest or motivate one skilled in the art to eliminate the problematic components.

Nitta, taken alone or in combination with Malhotra (in any order) does not cure this deficiency. Rather, Nitta is directed to a "recording sheet" made up of a number of different layers or laminates. Referring to Figure 1 of Nitta, a woven (A) or nonwoven (A') fabric sheet is bonded via adhesive (S) to a stretched resin film (B) having an image-receiving layer (II) thereon. Stretched resin film (B) is, as disclosed in Nitta starting at col. 5, line 42, "a waterproof film having Clark stiffness ... of from 8 to 300 ... and a thickness of from 20 to 300 μm ." If the Clark stiffness is below 8, "the film has insufficient strength to hold its shape" and if above 300 "can be stored only in the form of a stack of flat sheets." Examples of such films include polypropylene and high-density polyethylene.

The claims of the pending application are not directed to a laminate as taught by Nitta. Rather, independent claim 24 recites a weatherproof sheet comprising a cellulosic substrate having two substantially planar sides, and a durable weatherproofing coating layer impregnantly covering at least one of the sides thereof. Nitta does not teach or suggest this aspect of the invention. Rather, Nitta discloses gluing a relatively stiff film, such as a polypropylene film, to one side of a fabric. In no instance does Nitta teach or suggest impregnantly coating one side of a cellulosic substrate with a weatherproofing coating layer.

Thus, the combination of Nitta with Malhotra (with either serving as the primary reference) does not yield the weatherproof sheet of claims 24-43. Rather, such a combination will result in a stiff film as taught by Nitta being glued to the substrate of Malhotra. Such a combination in no way even resembles the recited subject matter of the pending claims, much less renders the same obvious in view of the combination.

Accordingly, Applicants respectfully submit that claims 24-43 are patentable over Malhotra and Nitta, taken either alone or in combination, and respectfully request that this ground of rejection be withdrawn.

Conclusion

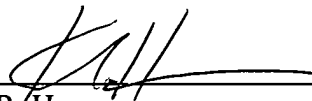
In view of the above amendments and remarks, Applicants submit that claims 24-43 are in condition for allowance. A good faith effort has been made to place this application in

condition for allowance. However, should any further issue require attention prior to allowance, the Examiner is requested to contact the undersigned at (206) 622-4900 to resolve the same.

Respectfully submitted,

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Enclosure:

“Walden’s Paper Handbook,” 3rd Ed., 1995, p. 20-107

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